

RECEIVED
CENTRAL FAX CENTER
MAY 29 2007

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Drew et al.) Examiner: LE, Tan
Serial No.: 10/792,326)
Filed: March 3, 2004)
For: Monitor Stand With Height Adjustment Mechanism)
Date of Last Office Action:) Attorney Docket No.:
November 7, 2006) 200314587-1
May 29, 2007)

PETITION TO DIRECTOR UNDER 37 CFR §1.181 and
PETITION FROM REQUIREMENT FOR RESTRICTION (37 CFR §1.144)

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant petitions the Director to review and withdrawn the Restriction Requirement of November 7, 2006 issued in the present application. An election with traverse was made on December 4, 2006.

CERTIFICATE OF FACSIMILE

Date of Deposit: May 29, 2007

I hereby certify that these papers are being transmitted to The Patent and Trademark Office facsimile number (571) 273-8300 on May 29, 2007.


Peter Krugljac

Docket No. 200207108-1

Remarks

This Petition is in response to the Restriction Requirement of November 7, 2006. Applicant has requested reexamination and reconsideration, and has traversed the restriction in an election filed December 4, 2006. This petition is being submitted not later than appeal. Thus, the petition should be considered under 37 CFR 1.144 and 37 CFR 1.181.

Applicant respectfully submits that the restriction fails to establish a prima facie case for the propriety of the restriction requirement. The restriction fails to provide any rationale to support its conclusion. Besides providing conclusory statements, no facts, examples, or other proof is provided to support the restriction. MPEP 808.01 requires that the Examiner provide particular reasons for holding that the inventions as claimed are either independent or distinct and that those reasons should be concisely stated. According to MPEP 806.05(e), "The burden is on the examiner to provide reasonable examples that recite material differences." Since the Examiner has not provided reasonable examples, a prima facie case for the propriety of the restriction requirement has not been presented. The restriction at the very least fails to comply with MPEP 808.01 and 806.05(e). The restriction cannot stand.

Therefore, the restriction is unwarranted and should be withdrawn. A more detailed explanation of the restriction and Applicant's supporting rationale is provided as follows.

Docket No. 200207108-1

Summary of The Restriction

The Office Action/Restriction of November 7, 2006 required restriction to one of the following species under 35 U.S.C. 121, as follows:

- I. Claims 1-7, drawn to a monitor stand height adjustment mechanism, classified in class 248, subclass 123.1.
- II. Claims 8-16, drawn to a monitor stand, classified in class 248, subclass 125.8.
- III. Claims 17-19, drawn to an apparatus, classified in class 248, subclass 122.1.
- IV. Claims 20-25, drawn to a monitor stand, classified in class 248, subclass 126. Applicant assumes that this paragraph includes a typographic error and that the Examiner intended to identify invention IV as concerning claim 20.
- V. Claims 21-25 drawn to a method for mechanically carrying out a monitor at a desired vertical position, classified in class 248, subclass 158.

Docket No. 200207108-1

Election

In response to the Restriction Requirement, Applicant elected Group I, claims 1-7, with traverse. The following references to the "Office Action" refer to the restriction of November 7, 2006.

Traversal

Paragraph 12 of the Office Action asserts that it "would be a serious burden on the examiner if restriction is not required." However, all five of the purportedly distinct inventions are classified in the same class (248), and two of the purportedly distinct inventions are even classified in the same subclass (125). Typically, a "serious burden" is not encountered when the purportedly distinct inventions are in the same class and sub-class.

Paragraph 2 of the Office Action asserts that inventions I and II are related as combination (II) and sub-combination (I). The Office Action asserts that the inventions are distinct, and thus subject to restriction, because the combination (II) as claimed does not require the particulars of the sub-combination (I) as claimed because the combination does not require a monitor support assembly operably connected to the first assembly. The Office Action also asserts that the sub-combination has a separate utility, such as a monitor stand not having a base. The second of these statements is incorrect, since the sub-combination (I) functions as a monitor stand height adjustment mechanism, not as a monitor stand.

Paragraph 3 of the Office Action asserts that inventions I and II are related as sub-combinations disclosed as useable together in a single combination. The Office Action asserts that the sub-combinations are distinct because they do not overlap in scope, because they are not obvious variants, and because at least one sub-combination is separately usable. Concerning these three prongs, the Office Action only discusses the third prong when it asserts that sub-combination I "has a separate utility such as use without a base." Thus, there is no evidence concerning two of the three prongs, and the reasoning concerning the third prong is incorrect. The statement concerning the third prong is incorrect because the sub-combination (I) functions as a monitor stand height adjustment mechanism, not as a monitor stand.

Docket No. 200207108-1

There are two paragraphs 4 in the Office Action. The first Paragraph 4 asserts that inventions I and III are related as sub-combinations disclosed as useable together in a single combination. The Office Action asserts that the sub-combinations are distinct because they do not overlap in scope, because they are not obvious variants, and because at least one sub-combination is separately usable. Concerning these three prongs, the Office Action only discusses the third prong when it asserts that sub-combination I "has a separate utility such as use without means for applying the frictional force between the means for guiding the direction of travel and the means for applying the lifting force." Thus, there is no evidence concerning two of the three prongs. Sub-combination I and III overlap in scope because both produce a lifting force and a frictional force that can be applied to support a monitor in a vertical position without locking the monitor in place.

The second Paragraph 4 asserts that inventions I and IV are related as sub-combinations disclosed as useable together in a single combination. The Office Action asserts that the sub-combinations are distinct because they do not overlap in scope, because they are not obvious variants, and because at least one sub-combination is separately usable. Concerning these three prongs, the Office Action only discusses the third prong when it asserts that sub-combination IV "has separate utility such as use without a monitor support assembly guide." Thus, there is no evidence concerning two of the three prongs. Sub-combination I and IV overlap in scope because both include a first assembly that produces a fixed lifting force and a second assembly that produces a configurable friction force. The combination of these forces can be used to maintain a monitor at a desired vertical position without locking the monitor in place.

Paragraph 5 asserts that Inventions-I and V are related as process and apparatus for its practice. The Office Action asserts that restriction is proper because the process as claimed can be practiced by another and materially different apparatus such as an apparatus not having a monitor. This rationale requires the elimination of elements and limitations in the claims. Claim 1 clearly recites "a monitor stand height adjustment mechanism" and claim 21 clearly recites "a method for mechanically carrying a monitor at a desired vertical position." The Office Action reasoning is flawed because it asserts that a method for carrying a monitor can be practiced without a monitor.

Docket No. 200207108-1

Paragraph 6 asserts that inventions II and III are related as sub-combinations disclosed as useable together in a single combination. The Office Action asserts that the sub-combinations are distinct because they do not overlap in scope, because they are not obvious variants, and because at least one sub-combination is separately usable. Concerning these three prongs, the Office Action only discusses the third prong when it asserts that sub-combination II "has separate utility such as use without a base." Thus, there is no evidence concerning two of the three prongs. Sub-combination II and III overlap in scope because both produce a lifting force and a frictional force that can be applied together to support a monitor in a desired unlocked position.

Paragraph 7 asserts that inventions II and IV are related as sub-combinations disclosed as useable together in a single combination. The Office Action asserts that the sub-combinations are distinct because they do not overlap in scope, because they are not obvious variants, and because at least one sub-combination is separately usable. Concerning these three prongs, the Office Action only discusses the third prong when it asserts that sub-combination II "has separate utility such as use without a base." Thus, there is no evidence concerning two of the three prongs. Sub-combination II and IV overlap in scope because both produce a lifting force and a frictional force that can be applied to support a monitor without requiring the position to be locked.

Paragraph 8 asserts that Inventions II and V are related as process and apparatus for its practice. The Office Action asserts that restriction is proper because the process as claimed can be practiced by another and materially different apparatus such as an apparatus not having a base. The Office Action thus asserts that the "material difference" is the presence or absence of a base. This supposed "materiality" is not the focus of the claimed invention and thus is improper for requiring a restriction. Claim 21 recites "a method for mechanically carrying a monitor at a desired vertical position without securing the monitor in that vertical position." Claim 8 recites "positioning a monitor in a user-selected stationary vertical position without locking the monitor in place". Thus, the relevant materiality concerns not having to secure a monitor in place, not whether the apparatus does or does not have a base.

Docket No. 200207108-1

Paragraph 9 asserts that inventions III and IV are related as sub-combinations disclosed as useable together in a single combination. The Office Action asserts that the sub-combinations are distinct because they do not overlap in scope, because they are not obvious variants, and because at least one sub-combination is separately usable. Concerning these three prongs, the Office Action only discusses the third prong when it asserts that sub-combination III "has separate utility such as use without a second monitor and a second weight." Thus, there is no evidence concerning two of the three prongs. Sub-combination III and IV overlap in scope because both produce a lifting force and a frictional force that can be applied to support a monitor without requiring the position to be locked.

Paragraph 10 asserts that Inventions III and V are related as process and apparatus for its practice. The Office Action asserts that restriction is proper because the process as claimed can be practiced by another and materially different apparatus such as an apparatus not having "means for applying frictional force between the means for guiding the direction of travel and the means for applying the lifting force". The Office Action thus asserts that the "material difference" is the presence or absence of means for applying frictional force between the means for guiding the direction of travel and the means for applying the lifting force. This supposed "materiality" is not the focus of the claimed invention and thus is improper for requiring a restriction. Claim 21 recites "a method for mechanically carrying a monitor at a desired vertical position without securing the monitor in that vertical position." Claim 17 recites means for supplying forces (e.g., lifting force, frictional force) that will hold an object at a desired but unlocked position. Thus, the relevant materiality concerns not having to secure a monitor in place, not where the frictional force is applied.

Paragraph 11 asserts that Inventions IV and V are related as process and apparatus for its practice. The Office Action asserts that restriction is proper because the process as claimed can be practiced by another and materially different apparatus such as an apparatus not having a second monitor with a second weight. The Office Action thus asserts that the "material difference" is the presence or absence of a second monitor. The second monitor is not claimed and thus is not part of the apparatus and thus its presence or absence cannot be used as rationale for requiring a restriction.

Docket No. 200207108-1

Conclusion

For the reasons set forth above, all restrictions are improper and should be withdrawn.
Applicant respectfully requests that the Director withdraw the restriction for all claims.

Respectfully submitted,



Peter Kraguljac (Reg. No. 38,520)
(216) 348-5843
McDonald Hopkins LLC
600 Superior Avenue, E.
Suite 2100
Cleveland, OH 44114